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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Johann Steiner

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5359

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06/14/2011

Syngenta Corp Protection, Inc.

410 Swing Road

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EXAMINER

FOLEY, SHANON A

ART UNIT

PAPER NUMBER

1648

MAIL DATE

DELIVERY MODE

06/14/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/580,583	Applicant(s) STEINER ET AL.
	Examiner SHANON A. FOLEY	Art Unit 1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 35-53 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 38-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/25/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group II in the reply filed on April 26, 2011 is acknowledged. The traversal is on the ground(s) that Assmann does not disclose a composition comprising fludioxonil to treat engineering materials.

Applicant's traversal has been fully considered, but is found unpersuasive. The requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features." Furthermore, Rule 13.2 defines "special technical features" as "those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art." Rule 13.2 defines "special technical features" as "those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art." In the instant case, the special technical feature linking each of the inventions is controlling microbial growth with an antimicrobial composition comprising fludioxonil. This special technical feature lacks novelty in the art because Assmann et al. (U.S. 5,985,903) teach active compounds which have strong microbicidal activity and are used to control undesirable microorganism, see column 14, lines 35-38. Such antimicrobial compositions include fungicides such as fludioxonil, see column 16, lines 60-65 and column 17, line 27. Accordingly, any subsequent patentably distinct invention lacks unity with the first group, see 37 CFR § 1.476 (d).

Applicant further argues that the search and examination of Groups I, II and III would not pose an undue burden.

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However, search burden is not a criterion of consideration under lack of unity practice.

Applicant additionally explains how instant claims 38-42 and 46-53 either depend from independent claim 35 or contain all of the claim features of instant claim 35.

Applicant requests that if instant claims 35 and 46 are found allowable, claims 38-42 and 46-53 should be rejoined.

In response, it is acknowledged that claims 38-42 and 46-53 share a corresponding special technical feature with instant claim 35, as does instant claims 1, 43-45, which is the basis for the finding of lack of unity regarding the special technical features shared among all of the inventive Groups.

Regarding the request for rejoinder, it is reiterated that where applicant elects claims directed to the product (as in the instant case), and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined. Note: rejoinder practice is not applicable to additionally non-elected products, such as those in Groups IV and VI.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product

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are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant further elects the species of propiconazole. While the election of species is appreciated, a species election is not applicable to the elected invention (Group II, claims 35-37).

The requirement is still deemed proper and is therefore made FINAL.

Claims 1 and 35-53 are pending, claims 1 and 38-53 are withdrawn due to non-elected subject matter and claims 35-37 are under consideration.

Information Disclosure Statement

The information disclosure statement filed May 25, 2006 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. None of the foreign references listed on the 1449 have a corresponding copy in the application file for consideration. All other references have been considered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 35 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Hanson et al. (Mycology Research. (March 2002); 106 (3): 321-328).

Hanson et al. teach sorbitol (SPDA) comprising $20 \mu\text{g/mL}^{-1}$ of propiconazole and $12 \mu\text{g/mL}^{-1}$ of fludioxonil, which falls within the instant ratios recited, i.e., 5:1 and 1:5. See the second sentence of the third paragraph of the first column on page 322, Figure 1, Table 1 and the paragraph bridging pages 3223-324.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson et al. and Neubert et al. (USPgPub 2004/0044040).

See the teachings of Hanson et al. Hanson et al. do not teach combining insecticides with the antimicrobial composition.

Neubert et al. teach combining compounds of insecticides, such as fipronil and imidacloprid, and fungicides, such as fludioxonil and propiconazole, see paragraph [0176].

One of ordinary skill in the art at the time the invention was made would have been motivated to have combined the specific insecticides and fungicides, as taught by Neubert et al., to provide a broad spectrum of agricultural protection, see Neubert et al. in paragraph [0176]. One of ordinary skill in the art at the time the invention was made would have had a reasonable expectation of success for combining the specific fungicides of Hanson et al. and Neubert et al. with the specific insecticides taught by Neubert et al. since there is no indication that there would be any reduction in functional inhibition when the fungicides and insecticides are combined and Neubert et al. teach that the weight ratios of the various mixing partners with the compounds of Neubert et al. range between 100:1 and 1:4, which would encompass the instant range recited in instant claim 36, since each of the mixing partners could be present in a 1:1 ration with the compound of Neubert et al.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHANON A. FOLEY whose telephone number is (571)272-0898. The examiner can normally be reached on flex, generally M-F 7AM - 3 PM, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zachariah Lucas can be reached on (571) 272-0905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SHANON A. FOLEY/
Primary Examiner
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